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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,330	09/19/2003	Kosaraju Krishna Mohan	54821.D1	6252

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INTERNATIONAL PAPER COMPANY
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EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,330

Applicant(s)

MOHAN ET AL.

Examiner

José A. Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on September 19, 2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it identifies the wrong application, i.e., the parent case, with the wrong filing date; see 37 C.F.R. 1.98 (i), shown below:

“(i) The application number of the application in which the information disclosure statement is being submitted.”

It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4. Regarding claims 1 and 18, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Objections

5. Claims 12-13 and 18 are objected to because of the following informalities: the use of the units, "SU," seems to be redundant. It has been previously established that the measured smoothness is the Sheffield smoothness. Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sandstrom et al., US Patent 6,379,497.

Sandstrom et al. teach a method of making containers, including cups, by sealably joining a paperboard having similar characteristics to the one recited in the independent claim, see abstract. Sandstrom et al. teach basis weights, densities of the paperboard within the claimed range, column 5, lines 37-60; the use of the expanded and/or unexpanded microspheres as claimed and addition amount in the same range, column 6, lines 50-65, column 33, lines 30-65, Tables 1 and 2. The caliper of the paperboard is shown to be within the claimed range, see tables 2-4A, columns 40, 43-44A. The coating of at least one surface is taught by Sandstrom et al. in column 12, lines 32-46 and column 12, line 57 through column 13, line 5. Note that the thickness of the applied coating is also within the claimed range; see column 22, lines 17-22. Even though Sandstrom et al., do not explicitly teach the Sheffield smoothness as claimed, this property **Must** be within the claimed range since the materials, addition amounts and process of making the paper is the same or very similar than the that of the present invention. Thus the paperboard made by Sandstrom et al. process meets the requirements of the claims or at least the minor modification(s) to obtain the claimed paperboard would have been obvious to one of ordinary skill in the art.

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As to claim 11, Sandstrom et al., teaches the coating of both surfaces in column 18, lines 36-51. Regarding claims 13 and 19, the printing of the surfaces is taught in column 32, lines 26-27.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent Nos. 6,740,373 or 6,919,111, US

Patent Application Publication Nos. 2005/0112305 or 2004/0209023 to Swoboda et al.

All of the above references teach the same/similar board than that of Sandstrom et al., US Patent 6,379,497 and therefore, these references anticipate or in the alternative the claims are obvious over Swoboda et al., above, for the same reasons.

6. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenaga et al., US Patent No. 3,293,114.

Kenaga et al. teach a paperboard comprising expandable microspheres in the same range as disclosed by applicants. They teach that the board can be use to make cups, i.e., making paperboard with low thermal conductivity per unit weight, see column 1, lines 26-40. They also teach that the spherical thermoplastic particles are usually added to the fiber slurry, i.e. along with the wet pulp prior to the deposition to the Fourdrinier, column 2, lines 55-59. The tables in the Kenaga et al. invention show properties of the board such as, basis weight, caliper, bulk, which fall/overlap the claimed range. Even though Kenaga et al. do not explicitly teach the other claimed properties, e.g., the bond strength and Sheffield smoothness of the board, these properties **Must** inherently be within the claimed range since there are made using the same process and using the same raw materials and at the same addition amount. Note also that optimizing result effective

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variables is within the levels of ordinary skill in the art. It has been held that “[T]he discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art. *In re Antoine*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); *In re Aller*, 42 CCPA 824, 220 F.2d 454, 105 USPQ 233 (1995).

Conclusion

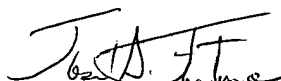
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of “Paperboard for insulated containers”

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



José A Fortuna
Primary Examiner
Art Unit 1731

JAF